

Remarks

Claims 1-5, 9-19 remain pending. Independent claim 12 has been amended as discussed below.

Summary of Telephone Interview with Examiner

Applicant thanks Examiner Holliday for discussing this application with Applicant's representative, Mukundan Chakrapani, on August 12, 2010.

The Examiner's response to Applicant's arguments filed on March 10, 2010 as summarized at pages 2 and 3 of the Office Action dated May 27, 2010, was discussed.

In particular, Applicant's representative pointed out the differences between the list of "unacceptable channels" as taught by cited prior art reference of Hicks et al and the list of "potential channels carrying signals having power in excess of a predetermined threshold" and "a complete list of potential channels having a power in excess of the predetermined threshold" as recited in the independent claims 1 and 12.

The Examiner agreed to reconsider the previously submitted arguments in light of the telephone discussions and requested that the previous arguments be resubmitted along with a Request for Continued Examination.

The Examiner also agreed to issue an Interview Summary confirming the telephone discussions.

Accordingly, Applicant resubmit the previously submitted arguments for the Examiner's reconsideration along with a Request for Continued Examination.

Claim Amendments

Applicant has taken this opportunity to amend independent device claim 12 for consistency in language with corresponding independent method claim 1.

Examiner's Response to Arguments

Applicant has taken this opportunity to reiterate the differences between the list of "unacceptable channels" as taught by cited prior art reference of Hicks et al and the list of "potential channels carrying signals having power in excess of a predetermined threshold" and "a complete list of potential channels having a power in excess of the predetermined threshold" as recited in the independent claims 1 and 12 as pointed out during the telephone interview of August 12, 2010.

At page 2 of the Office Action, the Examiner asserts that "the channels are scanned according to the band search list that is stored" and cites column 4, lines 32-35 of Hicks et al in support. Hicks et al, at column 4, lines 32-35, recites: "In a wide-band scan, it is typical for the mobile unit 12 to search through channel bands 30, usually in the order specified in the band search list of the IRDB, until a suitable control channel is located from an 'acceptable' service provider."

Thus, it is clear that the band search list of Hicks et al is not the list of potential channels carrying signals having power in excess of a predetermined threshold, which is created by scanning a selected subset of the associated channels in a predefined frequency band as recited in independent claims 1 and 12.

Furthermore, the Examiner asserts that in Hicks et al, "a list of unacceptable channels are created, but those channels allocated are acceptable are also stored in order to further determine channel signal strength" and cites column 5, lines 30-42 of Hicks et al in support. Hicks et al, at column 5, lines 30-48, recites (emphasis added):

The channel signal strength is compared against the minimum allowable RSS as determined by the F-BCCH message (box 190) to determine whether the channel 20 is suitable or not. The minimum allowable RSS level is typically significantly higher than the pre-determined threshold allowed at box 120. If the channel 20 fails, then the process loops back to check the next channel 20 (i.e., the second strongest channel 20 in the sub-band) (box 110) or the next sub-band (if the second channel 20 has

already been checked) (box 130). If the channel 20 passes, the channel is determined to be suitable, and the service provider information is checked (box 200).

If the service provider is from the "acceptable" class, then the mobile unit 12 camps on the control channel 20 (box 220). If the service provider is from the "unacceptable" class, the mobile unit stores the channel number, ends the channel band scan, and returns to the invoking procedure (box 210).

Clearly, in Hicks et al, if a channel is determined to be suitable and the service provider is from an "acceptable" class, the mobile unit camps on the control channel. No list of acceptable channels is created as a result of a successful determination. On the other hand, if the service provider is from the "unacceptable" class, the mobile unit stores the channel number to create a list of unacceptable channels so as to reduce the number of channels scanned and to save scan time (see column Hicks et al at column 7, line 56 to column 8, line 15).

Thus, the list of "unacceptable channels" as taught by Hicks et al is neither the list of "potential channels carrying signals having power in excess of a predetermined threshold" nor is it the "complete list of potential channels having a power in excess of the predetermined threshold" as recited in the independent claims 1 and 12.

As indicated to the Examiner during the telephone interview, Applicant resubmits the previously submitted arguments below.

Claim Rejections – 35 USC 103

The Examiner rejected claims 1-9 and 12-19 as being unpatentable over U.S. Patent No. 6,393,284 to Dent in view of U.S. Patent 6,052,590 to Hicks et al. The Examiner rejected claim 10 as being unpatentable over the combination of Dent and Hicks et al, and in further view if U.S. Patent 5,465,388 to Zicker. The Examiner also rejected claim 11 as being unpatentable over Dent and Hick et al, and in further view of U.S. Patent 5,258,981 to Davey et al. Applicant respectfully disagrees.

The Examiner has not made a *prima facie* case for rejection under section 103 because the references fail to disclose or suggest all claim elements.

Independent claims 1 and 12

Applicant Dent and Hicks et al, either alone or in combination, fail to teach all the elements of independent claims 1 and 12. In particular, the cited references neither disclose nor suggest scanning "one or more other subsets of the associated channels" to assemble "a complete list of potential channels having a power in excess of the predetermined threshold" upon identifying at least one channel in the list of potential channels as carrying the encoded signal, as recited in independent claims 1 and 12.

To make a *prima facie* case under section 103, the Examiner's burden includes (but is not limited to) citing references that teach or suggest all of the features of a claimed invention. E.g., *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995); *In re Wada and Murphy*, Appeal No. 2007-3733, slip op. at 7 (BPAI 2008). If the references fail to teach or suggest one or more elements, the Examiner's *prima facie* case is flawed for failing to meet this legal standard.

Dent does not teach or suggest scanning "one or more other subsets of the associated channels" to assemble "a complete list of potential channels having a power in excess of the predetermined threshold" upon identifying at least one channel in the list of potential channels as carrying the encoded signal, as recited in independent claims 1 and 12. The Examiner previously conceded that Dent does not teach or suggest the above-noted features (refer to telephone interview on August 14, 2009, and Response dated September 22, 2009). See also, Office Action dated December 28, 2009, at page 4 for additional deficiencies of Dent noted by the Examiner.

Hicks et al do not teach or suggest these features either. According to the Examiner, Hicks et al teach "to create a list of potential channels carrying having power in excess of a predetermined threshold (sub-band is [s]canned to identify two strongest channels, which are checked in order against a pre-determined threshold; if the service provider of the channel is unacceptable, the mobile unit stores the channel number [fig. 3, col. 4, line 59-65, col. 5, lines

30-48] wherein multiple channels are scanned that exceed a first RSS threshold reads on 'to create a list' (see Office Action dated December 28, 2009 at page 4, emphasis in original).

Applicant respectfully submits that merely scanning multiple channels is the not same as "creating a list of potential channels" as claimed in claims 1 and 12.

Moreover, the cited passages of Hick et al teach that "if the service provider is from that 'unacceptable' class, the mobile unit stores the channel number, ends the channel band scan, and returns to the invoking procedure" (see Hicks et al at col. 5, lines 45-48, emphasis added). Hicks et al, at best, creates a list of unacceptable channels. A list of unacceptable channels is not the same as a list of potential channels carrying signals having power in excess of a predetermined threshold, as recited in claims 1 and 12. In fact, it is quite the contrary.

The Examiner further stated that Hick et al teach "scanning one or more subsets of the associated channels, which together with the selected subset of the associated channels comprise the predefined frequency band" and cited Fig. 3 and the corresponding description at col. 5, lines 30-42 in support of her assertion.

Applicant respectfully disagrees that Hicks et al teaches scanning additional subsets upon identifying at least one channel in the list of potential channels as carrying the encoded signal, as recited in claims 1 and 12.

On the contrary, Figs. 3 and 4 and the associated description in Hick et al, teach scanning the next or additional sub-bands only if it is determined that the signal strength of a channel is below the RSS threshold and if no other channel exists in the selected sub-band (see decision box 120 in Figs. 3 and 4 of Hicks et al). Hicks et al do not teach or suggest "upon identifying at least one channel in the list of potential scanning "one or more other subsets of the associated channels" to assemble "a complete list of potential channels having a power in excess of the predetermined threshold" upon identifying at least one channel in the list of potential channels as carrying the encoded signal, as recited in independent claims 1 and 12.

As previously submitted, independent claims 1 and 12 recite that when a selected subset of associated channels in a predefined frequency band is scanned to create a list of potential channels carrying signals having power in excess of a predetermined threshold and when at

least one channel in the list of potential channels is identified as carrying an encoded signal; the remaining subsets of the associated channels, which together with the selected subset comprise the predefined frequency band, are then scanned to create a complete list of potential channels that carry the encoded signal. A connection between the mobile device and the network is established using the channel carrying the strongest signal within the channels identified as carrying the encoded signal.

Ordinarily, a device connects to the encoded signal carrying channel that has highest signal power. In the case where only a subset of the channels of the frequency band are scanned to find one or more channels carrying an encoded signal, one cannot be sure that any of said encoded signal carrying channels actually has the highest signal power of the possible channels in the complete set because channels of other subsets have not been scanned (at that time). Thus, the claimed method and device ensure that having identified, in one subset of associated channels, at least one encoded signal carrying channel having power in excess of a predetermined threshold, a complete scan of all channels is performed to identify all encoded signal carrying channels to create a complete list of potential channels. From the complete list of potential channels, the encoded signal carrying channel having the highest power is then identified and a connection between the mobile device and the network is established with that channel. The complete scan is performed by either scanning all channels of the frequency band including the already scanned subset or just scanning unscanned subsets in addition to the scanned subset.

This arrangement has the advantage that, when no signal is detected, only subsets of the frequency band are scanned thereby saving battery power. However, when a signal is detected during a scan of a subset of the channels, this provides an indication that it would now be a good time to perform a full scan to obtain a complete list of channels having an encoded signal. Thus, the present invention saves power through scanning only subsets of channels when no signal is detected but when a signal is detected during a scan of a subset of channels, a full scan is performed so that the connection is established using the channel with the highest power that carries the encoded signal (providing for example, better reliability of the connection, etc). Dent and Hicks et al do not teach or suggest full scanning if an encoded signal is detected during a scan of a subset of channels.

Clearly, Dent and Hicks et al do not teach or suggest each and every feature as recited in independent claims 1 and 12. Consequently, independent claims 1 and 12 are not obvious in light of Dent and Hicks et al. For at least the same reasons, their respective dependent claims are patentable over Dent, Hicks et al, Zicker and Davey et al. Withdrawal of the rejections under 35 USC 103 is respectfully requested.

Applicant submits that the Examiner's rejections have been addressed and cordially requests early reconsideration of this application.

A Request for Continued Examination is being concurrently filed.

The Commissioner is hereby authorized to charge any additional fees, and credit any over payments to Deposit Account No. 501593, in the name of Borden Ladner Gervais LLP.

Respectfully submitted,

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